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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/471,349	12/23/99	SAHNI	G 07064-009001

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EXAMINER

KERR, K

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

08/22/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

8/22/00

# Office Action Summary

Application No.  
**09/471,349**

Applicant(s)  
**Sahni et al.**

Examiner  
**Kathleen Kerr**

Group Art Unit  
**1652**



☒ Responsive to communication(s) filed on 7/10/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 18-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 18-26 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### *Application Status*

1. Claims 1-32 are pending in the instant application.

### *Restriction*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3 and 32, drawn to a hybrid plasminogen activator and compositions thereof, classified in class 530, subclass 350.
  - II. Claims 4-31, drawn to DNA segments, vectors, host cells, and methods of preparing a hybrid plasminogen activator, classified in class 435, subclass 69.1.

3. The inventions are distinct, each from the other, because of the following reasons:

The DNA of Group II is related to the protein of Group I by virtue of the fact that the DNA encodes the protein. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA and the protein are related, they are distinct inventions because the protein product can be made by other and materially distinct processes, such as organic synthetic or semi-synthetic methods. Furthermore, DNA can be used for processes other than the production of protein, such as nucleic acid hybridization assays. Therefore, Groups I and II are patentably distinct.

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***Election***

4. A telephone call was made to Mr. John Freeman on August 15, 2000 to request an oral election to the above restriction requirement but did not result in an election being made.

Applicants are advised that the reply to this requirement **MUST** include an election of the invention to be examined, even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Conclusion***


5. The reply to this requirement **MUST** include an election of the invention to be examined.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Kathleen M. Kerr whose telephone number is (703) 305-1229. The Examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone number for this Group is (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



PONNATHAPUJACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

KMK

August 16, 2000